

Applicants respectfully traverse the rejection of claims 2 and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action states that claims 2 and 8 do not further limit claims 1 and 7, respectively, because claims 2 and 8 “contain only functional/intended use limitations.” Applicants respectfully submit that claims 2 and 8 do further limit claims 1 and 7, respectively, and that the recitations in claims 2 and 8 are not merely functional/intended use limitations. More particularly, the recitations in claims 2 and 8 describe the arrangement of the first and second ditch portions in the band of the ring. In other words, claims 2 and 8 describe the location of the first and second ditch portions on the band of the ring, only the location of the first and second ditch portion is described in terms of the ditch portions relationship to the hand and finger of the wearer of the ring when the ring is worn on the hand and finger of a wearer of the ring. U.S. patent procedure allows for an applicant to describe an article that is to be worn by a person in terms of the body the article is to be worn on in the same manner as, for instance, describing an article for use in an automobile where the article is described in terms of the size and relationship with the automobile parts without positively reciting any of the automobile parts. Claims 2 and 8 basically recite that the first and second ditch portions are arranged approximately 180 degrees apart from each other in the outer circumferential surface of the band. However, since Applicants are allowed to be their own lexicographers, it is perfectly acceptable for them to describe the location of the ditch portions in terms of their relationship to the finger and hand of the wearer of the ring when the ring is worn on the hand and finger of the wearer of the ring. Based on the foregoing, Applicants respectfully request withdrawal of the objection to claims 2 and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicants also respectfully traverse the rejection of claims 1-6 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over *the Abstract of Japanese Patent Publication No.*

410075809A (hereinafter "*Abstract of JP '809*") in view of *Slowinski*, and the rejection of claims 7-12 under 35 U.S.C. § 103(a) as being unpatentable over *Abstract of JP '809* in view of *Slowinski* and *Kirshbaum*.

As a quick synopsis of two of the three applied prior art references, Applicants hereby repeat the *Abstract of JP '809* and the abstract of *Slowinski*, as follows:

The *Abstract of JP '809* discloses a ring R which is made up of a ring section 1 and hard ornaments 2, 3 provided opposite each other with respect to a center thereof. The material and color of the ring section 1 are similar to those of existing rings and are optional. The ring section 1 can be completely circular and of a fixed size or adjustable size. The hard ornaments 2, 3 are of optional material, shape, color, and size, including jewels, ambers, or pearls, and are attached to the ring section 1. At least one of the hard ornaments 2, 3 is a lumpish object which is attached in a manner protruding outwardly from the ring section 1. Then, the two ornaments 2, 3, which are attached to one ring, are made up of jewels which are different at least in either of material, shape, color, and size, and are contrastively beautiful in appearance. The Abstract of JP '809 discloses that the problem to be solved by the ring is to "appreciate the appearance and beauty of two ornaments with one ring by providing hard ornaments on opposite sides with respect to the center of the ring section and **making one ornament a lumpish object protruding in the opposite side from the center of the ring section.**" (Emphasis added).

Slowinski discloses a setting for diamonds in a jewelry piece which includes an annular groove defined by upstanding, spaced walls and a base. The groove is bordered by two upstanding rims and diamonds are placed in the groove in a row in abutting relationship. The diamonds are supported on ledges that are formed between the walls and the rims, on sharp pointed edges which comprise a small amount of yielding gold material to allow the

diamonds to be precisely aligned height-wise relative to one another. The rims are overturned on the peripheries, i.e., crowns, of the diamonds to clamp the diamonds in the groove.

On page 3, lines 14-15, the Office Action states that the *Abstract of JP '809* discloses a ring with stones affixed on opposite sides of the ring, but lacks ditch portions and that *Slowinski* discloses the use of ditch portions to set a stone below the surface of the band. On page 3, lines 16-19, the Office Action also states that "It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the stones to be set in ditch portions in view of *Slowinski* in order to provide a means of allowing the stones to be cleaned easily and to prevent the stones from being damaged from impacts to the ring surface."

First, with respect to the Office Action's above-quoted motivation to combine statement, Applicants respectfully submit that it is not understood how setting the stones or hard ornaments 2, 3 of the *Abstract of JP '809* into the ditch portions or peripheral annular grooves 14 similar to those of *Slowinski* made in the ring section 1 of the ring R of the *Abstract of JP '809* would allow the stones to be more easily cleaned. The stones or hard ornaments 2, 3 of the *Abstract of JP '809* are shown in the Figure attached thereto as being held in a setting having prongs or tines so that a majority of the outer periphery of the stones or hard ornaments 2, 3 is capable of being easily cleaned. However, if the stones or hard ornaments of the *Abstract of JP '809* were recessed into the ditch portions or peripheral annular grooves 14 of *Slowinski* made in the ring section 1 made in the ring section 1 of the ring R of the *Abstract of JP '809*, the stones or hard ornaments 2, 3 would be harder to clean because less of the outer peripheries of the stones or hard ornaments 2, 3 would be showing and therefore, harder to get at to clean.

Second, Applicants respectfully submit that there is no way the hard ornaments 2, 3 disclosed in the *Abstract of JP '809* could be set so as to be held entirely in a ditch or recessed portion of the ring section 1 or band of the ring R of the *Abstract of JP '809* because the ring section 1 is not deep enough to recess the hard ornaments 2, 3 completely therein. Although it is true that patent drawings are not necessarily to scale, it is clear from the Figure of the *Abstract of JP '809* that the hard ornaments 2, 3 are much bigger than the ring section 1 and thus, there is no way that the hard ornaments 2, 3 could be recessed into the ring section 1 and not jut out therefrom.

Indeed, it is clear from the *Abstract of JP '809* that it was the intent of the invention that the hard ornaments 2, 3 project outwardly from the ring section or band 1 in order to “appreciate the appearance and beauty of the two ornaments” because the *Abstract of JP '809* specifically states that one of the hard ornaments 2, 3 is a “lumpish object and attached in a manner of protruding outwardly from the ring section 1.”

Further, Applicants are hereby providing a translation of claim 1 and paragraph nos. 0013, 0014, and 0016 of *JP '809*, the translation being attached at the end of this Request for Reconsideration (see Attachment 1). A review of the translation of claim 1 and paragraph nos. 0013, 0014, and 0016 of *JP '809* reveals that a characteristic structural element of *JP '809* is that at least one of the two hard ornaments 2, 3 is defined as an outwardly-protruded lumpish object. As a result of this structural characteristic, *JP '809* discloses that whenever the wearer of the ring R having the lumpish object 2 or 3 attached thereto closes his/her hand, the lumpish hard ornament 2 or 3 comes into contact with the wearers palm and causes a pressure against the palm, thereby producing an acupressure effect and making the wearer aware of the existence of the lumpish hard ornament 2 or 3. This characteristic feature is not recognizable by the ring of the present invention.

In other words, it is an essential structural requirement of the ring R of *JP '809* that at least one of the hard ornaments be an outwardly protruded lumpish object so as to cause pressure against the wearer's palm when the wearer closes his/her hand. Since this essential characteristic structural feature would be completely lost if the groove 14 disclosed in *Slowinski* were placed in the ring section 1 of the ring R of the *Abstract of JP '809* so that the hard ornaments 2, 3 were at least partially embedded or recessed into the ring section 1, Applicants respectfully submit that one of ordinary skill in the art would never be motivated to combine the *Abstract of JP '809* with *Slowinski* because the ring R of the *Abstract of JP '809* would be modified to be unsuitable for its intended purpose.

Stated another way, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to combine the *Abstract of JP '809* and *Slowinski* because putting the recessed annular grooves of *Slowinski* in the ring section 1 of the ring R disclosed in the *Abstract of JP '809* would leave the ring R disclosed in the *Abstract of JP '809* unsuitable for its intended purpose because the true beauty and appearance of the hard ornaments 2, 3 could not be appreciated if a portion of the bottom or the entire bottom of the hard ornaments 2, 3 were sunk or recessed in the ring section 1.

Further, it is clear that one of ordinary skill in the art would never think of combining the *Abstract of JP '809* and *Slowinski* by placing the ditch portions or peripheral annular groove 14 of *Slowinski* in the ring section 1 of the ring R of the *Abstract of JP '809* in order that the hard ornaments 2, 3 be recessed in the ring section 1 because combining the two references is self-contradictory since it is the intent of the *Abstract of JP '809* to have the hard ornaments 2, 3 protrude and it is the intent of *Slowinski* to completely recess the stones below the outer peripheral surface of the band of the ring.

Applicants respectfully submit that claims 2-6 are either directly or indirectly dependent upon claim 1 so that arguments serving to patentably distinguish claim 1 from the prior art of record are available, among others, to patentably distinguish claims 2-6. Applicants also respectfully submit that claims 8-12 are all directly dependent upon claim 7 so that arguments serving to patentably distinguish claim 7 from the prior art of record are available, among others, to patentably distinguish claims 8-12. Applicants also respectfully submit that claims 14 and 15 are either directly or indirectly dependent upon claim 13 so that arguments serving to patentably distinguish claim 13 from the prior art of record are available, among others, to patentably distinguish claims 14 and 15. Based on the foregoing, Applicants respectfully request withdrawal of all of the rejections of the claims under 35 U.S.C. § 103(a) based on any combination of *the Abstract of JP '806, Slowinski*, and *Kirshbaum*, and allowance of claims 1-15.

In view of the present amendment, amended claims 1-15 are believed to be in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gay Ann Spahn

Gregory J. Maier
Registration No. 25,599
Gay Ann Spahn
Registration No. 34,978
Attorneys of Record



22850

GJM/GAS:yes
Phone No.: (703) 413-3000;
Fax No: (703) 413-2220; and
E-mail Address: gspahn@oblon.com
I:\atty\gas\211861\Revd Req 4 Reconsid.wpd